

REMARKS

Claims 50-54 and 83-95 are pending. Claims 50-54 have been withdrawn from consideration. Claims 83-95 stand rejected.

Claims 83 and 89 have been amended. Support for the amendment can be found, *inter alia*, at pages 3:7-9 and 30:23-24 of the Specification and in Figs. 49 and 52. No new matter is added by the amendments or new claims presented herein. Applicants submit that the amendments presented herein place the application in condition for allowance, or, in the alternative, in better condition for appeal, and accordingly respectfully request entry of the amendments.

Applicants have reviewed the Office action, including the Examiner's remarks and the references cited therein. Applicants submit that the following remarks are fully responsive to the Office action, and that all pending claims are patentable over the cited references.

Request for Reconsideration of Finality

The Office action is a second action containing several new grounds of rejection. A second action containing new grounds of rejection cannot be made final unless the new grounds of rejection are "necessitated by applicant's amendment *of the claims*" or "based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." MPEP § 706.07(a) (emphasis added). The Examiner maintains that the new grounds of rejection in the Office action are "necessitated by applicant's amendment *of the priority data*." Interview Summary (Feb. 11, 2008) (emphasis added). An amendment to the priority data, however, is *not* a proper basis for making the new grounds of rejection final.

Moreover, the Examiner improperly required the amendment to the priority data in the first instance. The Examiner *sua sponte* withdrew claims 50-54 and 75-82 from consideration because "the instant application has been filed as a continuation of US Patent Application Serial No. 09/507,336, rather than a divisional, [and therefore] the instant application must be drawn to the same invention" September 10, 2007 Office action, at 4. As Applicants noted in response to the September 10, 2007 Office

action, there is no requirement that claims in a continuation application be drawn to the same invention as the parent application. To the contrary, an election in a parent application only carries over *only* in case of a continued prosecution application (CPA). MPEP § 819. Thus, the Examiner erred in requiring Applicants to amend the priority of the present application to be a divisional, rather than a continuation, in order to receive consideration of claims different from those in the parent application. The Examiner cannot rely upon this erroneously-required amendment in making the Office action final.

For at least the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the finality of the Office action.

Rejections Under 35 U.S.C. § 102

The Examiner rejects claims 83, 89, 90, and 94 under 35 U.S.C. § 102(b) as anticipated by United States patent no. 4,207,874 to Choy ("Choy") and United States patent no. 6,139,492 to Vierra et al. ("Vierra"). To be anticipatory, a single prior art reference must explicitly or inherently teach each and every element of the claimed invention. MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). Applicants respectfully submit that neither Choy nor Vierra meets this standard.

Claim 83 recites, *inter alia*, "an ablating device adapted to be adhered to an *epicardial surface*" and including "at least one suction well that *surrounds a perimeter* of the at least one ablating element, wherein a closed wall *defined by an inner lip of the at least one suction well* surrounds the perimeter of the at least one ablating element." (Emphasis added.)

As described beginning on page 30 of the Specification and as illustrated, *inter alia*, in Figs. 49 and 52, one aspect of the present invention is a device for epicardial ablation, for example a device that wraps about at least a portion of an epicardial surface as shown in Fig. 49. To facilitate contact between the device and the epicardial tissue being ablated, some embodiments of the invention include one or more suction wells to adhere the device to the epicardium via the application of vacuum. For example, a suction well (310) may surround the perimeter of an ablating element (311)

within a given cell (304) of the ablation device as shown in Fig. 52. An inner lip (312) of the suction well may define a closed wall (319) that surrounds the perimeter of the ablating element.

Choy, on the other hand, teaches a laser tunneling device intended to break apart an obstruction within a tube (e.g., a blood vessel) and that utilizes suction to remove the pieces of the obstruction so broken. Choy, 3:6-8 ("The laser energy vaporizes the obstruction, *which is constantly removed by the suction ...*") (emphasis added); 4:48-53. Choy therefore does not teach "an ablating device adapted to be adhered to an epicardial surface" as recited in claim 83.

Choy also fails to teach "at least one suction well that *surrounds a perimeter* of the at least one ablating element, wherein a closed wall *defined by an inner lip of the at least one suction well* surrounds the perimeter of the at least one ablating element."

The Examiner asserts that "the portion of the device distal of the tip of the optical fiber [e.g., head 18] constitutes a suction well" Office action, p.2. It is clear from Fig. 1 and 2 of Choy, however, that head 18 of the device does not "surround a perimeter of" the optical fiber. Indeed, the Examiner acknowledges that this alleged suction well is "distal of the tip of the optical fiber." Nor does Choy's head 18 have an inner lip that defines a closed wall that surrounds the perimeter of the at least one ablating element.

For at least the reasons above, Applicants respectfully submit that Choy does not anticipate claim 83.

As to Vierra, the Examiner does not provide any citations in support of the assertion that Vierra allegedly anticipates the claimed invention. Applicants respectfully submit that Vierra does not teach or suggest "[an] elongate body having at least one ablating element" as recited in claim 83. It follows that Vierra does not teach or suggest "at least one suction well that surrounds a perimeter of the at least one ablating element" or "a closed wall [that] surrounds the perimeter of the at least one ablating element." Vierra therefore cannot anticipate claim 83.

For at least the foregoing reasons, Applicants respectfully submit that neither Choy nor Vierra anticipates claim 83. Claims 89, 90, and 94, which depend from claim

83, are allowable for at least the same reasons. The rejections under 35 U.S.C. § 102(b) should therefore be withdrawn.

Rejections Under 35 U.S.C. § 103

The Examiner rejects claims 84-88, 91-93, and 95 under 35 U.S.C. § 103 as obvious over Choy. The examiner also rejects claims 84-88, 91-93, and 95 under 35 U.S.C. § 103 as obvious over Choy in view of Vierra. Applicants respectfully disagree.

Though the prior art references need not teach or suggest each and every limitation of a claim for that claim to be obvious, Applicants contend that the differences between the rejected claims and the references cited are sufficiently great so as to render the claimed invention non-obvious to one of ordinary skill in the art at the time the invention was made. Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57527-28 (Oct. 10, 2007) (“[T]he focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and *on what such a person would have reasonably expected to have been able to do in view of that knowledge.*”) (emphasis added). In particular, as discussed in further detail below, Applicants respectfully submit that one of ordinary skill in the art would not have learned the claimed invention from the asserted references.

Claims 84-88, 91-93, and 95 depend from claim 83. The shortcomings of Choy and Vierra with respect to claim 83 are discussed at length above. For at least the reasons discussed above, Applicants submit that claims 84-88, 91-93, and 95 are substantially different from, and therefore non-obvious over, Choy, Vierra, and the combination of the two.

Claims 91-93 are patentable over Choy, Vierra, and the combination of the two for additional and independent reasons. Claim 91 recites “a pressure sensor ... adapted to detect the adequacy of contact of the suction well to a tissue.” Claim 92 recites “a flow rate sensor ... adapted to detect the adequacy of contact of the suction well to a tissue.” Claim 93 recites “an electric circuit ... adapted to detect the adequacy

of contact of the suction well to a tissue.” The Examiner asserts that each of these sensors is “equivalent to the reservoir 30 of Choy” Office action, p.3. Applicants respectfully disagree.

Choy’s transparent reservoir is neither a pressure sensor, a flow rate sensor, nor an electric circuit. Nor is Choy’s transparent reservoir “adapted to detect the adequacy of contact of the suction well to a tissue.” Instead, Choy’s reservoir is adapted to detect when the obstruction being broken apart has been breached “to prevent undesirable consequences with respect to removal and/or obstruction [sic] what is beyond the obstruction 14.” Choy, 4:53-58; *see also* 3:10-12. Accordingly, Choy’s reservoir serves its intended purpose *only* in an application where tissue is being broken apart and removed—an application contrary to that of the present invention. One of ordinary skill in the art therefore would not incorporate Choy’s transparent reservoir into the present invention in order to “detect the adequacy of contact of the suction well to a tissue[,]” at least because Choy’s transparent reservoir would be rendered inoperative in the present invention. The Examiner’s conclusion to the contrary is clearly based upon the improper application of hindsight in view of the present invention.

For at least the foregoing reasons, claims 84-88, 91-93, and 95 are substantially different from, and therefore non-obvious over, Choy and Vierra standing alone or in combination. Accordingly, the rejection under 35 U.S.C. § 103 should be withdrawn.

Double Patenting Rejections

The Examiner rejects claims 83-95 on the ground of non-statutory, obviousness-type double patenting over claims 1-25 of United States patent no. 5,830,214 to Flom et al. (“Flom”). Applicants submit that this rejection is improper because Flom is not commonly-owned with the present application. MPEP § 804.

The Examiner provisionally rejects claims 83-95 of the ground of non-statutory, obviousness-type double patenting over claims 1-25 of United States application no. 11/882,072. Applicants will submit a terminal disclaimer to overcome this double patenting rejection upon receiving an indication of allowable subject matter in the application.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that the application is in condition for allowance, and request that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

No extension of time is believed necessary for this paper to be considered timely. Should an extension of time be deemed necessary, Applicants hereby petition therefor under 37 C.F.R. § 1.136.

Authorization is hereby granted to charge any fees due with the filing of this document, including any fees for any extensions of time deemed necessary, to Deposit Account No. 50-1129 with reference to Attorney Docket No. 0E-040042US/82410-0181.

Respectfully submitted,

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